

REMARKS

Claims 2 and 4-7 remain pending in the present application. Claim 7 has been amended in this response. No new matter has been introduced as a result of the amendment.

Claims 4 and 6-7 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Davis et al.* (U.S. Patent No. 4,436,962) in view of *Herrick et al.* (U.S. Patent No. 5,521,970). Claims 2 and 5 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Davis et al.* (U.S. Patent No. 4,436,962) in view of *Herrick et al.* (U.S. Patent No. 5,521,970), and further in view of *Brown et al.* (U.S. Patent No. 5,309,028). Applicants traverse the rejections. Favorable reconsideration is respectfully requested.

Specifically, the prior art, alone or in combination, does not disclose “assigning the plurality of subscriber lines to a call acceptance group among a plurality of the multiple communications systems” along with the other related features recited in claim 7. It has been conceded by the Examiner that Davis does not disclose this feature. In this regard, the Office Action relied on Herrick to conclude that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to further modify the method by configuring the call acceptance group such that first said first subscriber terminal . . . and said at least second subscriber terminal . . . belong to multiple communications systems . . . thus providing a method for call forwarding in which – from a user viewpoint – the call coverage across a network of switches behaves identically, as it does on a single switch” (Office Action pages 4-5). Applicants respectfully submit that this analysis is incorrect.

First, the system in Herrick does not address assigning call acceptance groups among a plurality of the multiple communications systems, but instead deals with redirecting calls to endpoints between two PBX systems (10, 20). Herrick teaches in FIG. 1 that each PBX 10 and 20 serves its own complement of communications endpoints, also called terminals, 11-12 and 21-22, respectively. Each PBX 10 and 20 is connected to network 9 by a plurality of user-communications links 15 and 25, and control data signaling links 16 and 26, respectively (col. 3, lines 11-16). Included among the control data stored in memory 14, 24 are coverage paths 110-120, 140-150, respectively. Each coverage path is associated with a different terminal 11-12, 21-22. Each coverage path includes a sequence of a plurality of entries 99. Each entry 99 identifies a different endpoint or terminal to which incoming calls destined for the associated endpoint or terminal may be redirected (col. 3, lines 28-34). Accordingly, Herrick does not have the

capability to establish call acceptance groups as required by the present claims, but instead sequentially addresses each terminal according to the control data.

This is punctuated by the fact that Herrick must go through a call-by-call query of switches outside of the initial covering switch, to determine if the switch is a “cooperating” switch (col. 4, lines 11-41; col. 6, lines 45-61). Indeed, the passage cited in the Office Action (col. 2, lines 11-40) describes the sequence through which an endpoint is queried, and a second switch signaling a first switch to maintain control over a call that had failed to connect to the second system. With this effect, a querying switch can continue the query other switches while remaining transparent to the user. Accordingly, the disclosure in Herrick makes clear that call acceptance groups cannot be formed between communications systems, as the call forwarding of Herrick must be validated each time a call connection is sought.

As a result, the teaching in Herrick makes it improper to combine with that disclosed in Davis. There is no teaching, suggestion or motivation for one skilled in the references in the manner suggested by the Office Action. Since call acceptance groups are not taught in Herrick, the combination with Davis renders Davis unsatisfactory for its intended purpose (MPEP 2143.01).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir.

1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

In light of the above, Applicant respectfully submits that the present claims are both novel and non-obvious over the art of record. Accordingly, the present application is in condition for allowance and requests that a timely Notice of Allowance be issued in this case. A petition for a three-month extension of time, along with a check in the amount of \$1,020.00 is enclosed herein. If any additional fees are due in connection with this application as whole, the office is hereby authorized to deduct said fees from Deposit Account No. 021818. If such a deduction is made, please indicate the attorney docket number (112740-187) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY _____

Peter Zura

Reg. No. 48,196

P.O. Box 1135

Chicago, Illinois 60690-1135

Phone: (312) 807-4208

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